

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS & AMENDMENTS

Claims 1-30 were pending in this application when last examined. Claims 1-7, 9, 10, 23, 24, and 26-28 have been examined on the merits, and stand rejected. Claims 8, 11-22, 25, 29, and 30 have been withdrawn from consideration.

Support for the amendment to claim 2 can be found in the Specification, for example, at page 11, lines 4-5.

Support for the amendment to claims 7 and 24 can be found in the Specification, for example, at page 21, lines 13-21.

Applicants reserve the right to file a continuation or division application on any canceled subject matter.

The Specification at page 20, lines 4-14, at page 20, line 27 to page 21, line 9, and at page 21, line 23, has been amended to provide the appropriate SEQ. ID. NOs. as suggested by the Examiner and to correct inadvertent typographical errors. The Specification has also been amended to replace the Sequence Listing of record with the attached substitute Sequence Listing. Support for these amendments can be found in the originally filed Specification at the same locations and in the newly revised Sequence Listing.

Therefore, no new matter has been added by this amendment.

II. OBJECTION TO THE SPECIFICATION

The Specification has been objected to for failing to provide SEQ. ID. NOs. for the amino acid sequences disclosed on page 20, lines 6-15. See Office Action, page 2, Item 3. Applicants respectfully traverse this objection in view of the foregoing amendments and the following remarks.

Enclosed is a new Sequence Listing that includes the previously omitted amino acid sequences as noted by the Examiner. The Specification has also been amended to include the appropriate SEQ. ID. NOs. In view of the foregoing amendments, the present objection is untenable and should be withdrawn.

III. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 7, 24, 26, 27 and 28 stand rejected for purportedly being vague and indefinite. See Office Action, page 2. Applicants respectfully traverse this rejection as it applies to the amended claims.

Claims 7 and 24 have been amended to recite "which correspond to amino acid positions 13 and 14 of SEQ. ID. NO. 3" as suggested by the Examiner and as described in the Specification, for example, at page 21, lines 13-21. In view of the foregoing amendments, the present rejection is untenable and should be withdrawn.

IV. REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, ENABLEMENT

Claim 6 stands rejected on the basis that the Specification allegedly lacks an enabling disclosure for the deposited hybridoma. See Office Action, page 3. Applicants respectfully traverse this rejection in view of the following remarks.

Enclosed herewith is a Declaration of Microorganism Availability under 37 C.F.R. §§ 1.801 - 1.809 as requested by the Examiner. This declaration states that the hybridoma with Accession No. FERM BP-7779 has been deposited under the terms of the Budapest Treaty and will be irrevocably and without restriction or condition released to the public upon the issuance of a patent. Thus, in view of the attached declaration, the present rejection is untenable and should be withdrawn.

V. REJECTION UNDER 35 U.S.C. § 102

Claims 1-5, 7, 9 and 10 stand rejected under 35 U.S.C. § 102 (b) as allegedly anticipated by Shimomura et al., EP 0 596 524 (form P.T.O. 1449), as evidenced by Goldsby et al.,

IMMUNOLOGY, 5th Ed., pp. 137-139 (2000). See Office Action, page 4. Applicants respectfully traverse this rejection in view of the foregoing amendments and the following remarks.

Shimomura fails to anticipate the claimed invention because the cited reference fails to teach each and every element of the claimed invention, namely, an antibody that does not substantially recognize inactive HGFA.

To anticipate a claim, a cited prior art reference must either expressly or inherently teach each and every element of the claimed invention.

In the instant case, Shimomura neither expressly nor inherently teaches an antibody that does not substantially recognize inactive HGFA. Applicants note that all of the monoclonal antibodies recognizing active HGFA that were known to the public at the time of the priority date of the present application are presented in Fig.1 of Miyazawa et al., J. BIOL. CHEM., 271(7), pp. 3615-3618 (1996) (Miyazawa is also one of the inventors of the instant application). In the instant application, the inventors analyzed the reaction specificity for these antibodies (i.e., 7E10, P1-4, A-1, A-6, A-23, A-32, A-51, and A-75) that were known in the public at the time of the priority date of the instant application to recognize HGFA. See Specification, page 52, line 6 to page 53, line 20 (Example 4) and Fig. 1. They found that these antibodies reacted not only with active HGFA, but **also inactive HGFA**. By contrast, the antibodies of the claimed invention do **not** substantially recognize inactive HGFA. Accordingly, the antibodies of Shimomura and Miyazawa which recognize inactive HGFA are not the same as those of claimed invention which do not substantially recognize inactive HGFA. Therefore, Shimomura cannot be said to inherently teach each and every element of the claimed invention. Consequently, Shimomura cannot anticipate the claimed invention.

Furthermore, unlike amended claim 2, neither Shimomura nor Goldsby disclose an antibody with a dissociation constant of 1×10^{-9} M or lower.

Therefore, in view of the foregoing amendments and remarks, the rejection of claims 1-5, 7, 9, and 10 under 35 U.S.C. § 102 (b) is untenable and should be withdrawn.

VI. REJECTION UNDER 35 U.S.C. § 103

Claims 23, 24, and 26-28 stand rejected under 35 U.S.C. § 103 as allegedly unpatentable over Shimomura et al., EP 0 596 524, in view of Zuk et al., U.S. Patent No. 4,281,061. See Office Action, page 5. Applicants respectfully traverse this rejection for the same reasons set forth immediately above and for the reasons discussed below.

The cited art references fail to render the claimed invention obvious because they fail to teach and/or suggest each and every element of the claimed invention, namely, antibodies that do not substantially recognize inactive HGFA.

To establish obviousness, three criteria must be met. First, the prior art references must teach or suggest each and every element of the claimed invention. Second, there must be some suggestion or motivation in the references to either modify or combine the reference teachings to arrive at the claimed invention. Third, the prior art must provide a reasonable expectation of success.

In this case, the rejection relies solely upon the primary reference of Shimomura for disclosing antibodies that recognize HGFA. However, as discussed above, Shimomura only discloses antibodies that recognize **both** active and inactive HGFA. Unlike the instantly claimed antibodies, Shimomura fails to teach and/or suggest antibodies that do not substantially recognize inactive HGFA.

Zuk fails to remedy this deficiency because Zuk fails to even discuss antibodies reactive to HGFA.

Thus, in view of the above, the claimed invention is not obvious over the cited references because the cited art references fail to teach each and every element of the claimed invention, and they lack a suggestion to combine/modify the reference teachings to arrive at the claimed invention. Therefore, in view of the foregoing amendments and remarks, the rejection of claims 23, 24, and 26-28 under 35 U.S.C. § 103 is untenable and should be withdrawn.

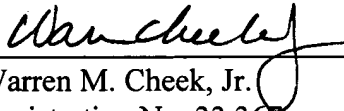
CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the present application is in condition for allowance and notice to that effect is hereby requested.

If it is determined that the application is not in condition for allowance, the Examiner is invited to telephone the undersigned attorney at the number below to expedite prosecution of the present application.

Respectfully submitted,

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ATTACHMENT TO AMENDMENT AND REPLY:

1. Declaration of Microorganism Availability
2. Sequence Listing